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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,065	12/20/2000	Michael Hachigian	10003586-1	1610

7590 09/30/2004  
HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P. O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER

ZHOU, TING

ART UNIT PAPER NUMBER

2173

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b>	Application No. 09/747,065	Applicant(s) HACHIGIAN ET AL.	
	Examiner Ting Zhou	Art Unit 2173	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 13 May 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☒ affidavit, b) ☒ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 1, 3-25 and 27-28

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

**BEST AVAILABLE COPY**

**NO (KEVIN) NGUYEN  
PRIMARY EXAMINER**

*Advisory Action  
(Continued)*

1. The declaration of prior invention in the United States to overcome cited patent (37 C.F.R. 1.131), submitted on 13 May 2004, has been received.
2. The declaration and the exhibits submitted therewith have been considered but does NOT place the application in condition for allowance because:
3. The declaration of prior invention in the United States to overcome cited patent (37 C.F.R. 1.131) was not executed by the proper parties to meet the formal requirements of affidavits and declarations mandated in MPEP 715.04. According to MPEP 715.04, "all the inventors of the subject matter claimed" (MPEP 715.04 - section I) are required to make an affidavit or declaration under 37 CFR 1.131. However, the declaration received on 13 May 2004 states "the persons making this declaration are only some of the joint inventors". The declaration fails to give and prove one of the valid reasons for making an affidavit by less than all named inventors mandated in MPEP 715.04 (section I. B-D), i.e. the applicants have not shown that "less than all named inventors of an application invented the subject matter of the claim or claims under rejection", "a petition under 37 CFR 1.47 was granted or the application was accepted under 37 CFR 1.42 or 1.43", or "the assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor." Therefore, the declaration fails to be executed by the proper parties as formally required.

4. However, in order to speed prosecution, although the declaration filed fails to meet the above mentioned formal requirements, the examiner will consider the declaration and exhibits received.

5. The applicants rely upon the invention disclosure to establish conception and actual reduction to practice of the invention. However, the applicants fail to state how to achieve or implement the invention. According to MPEP 715.07, "A conception of an invention, though evidenced by disclosure, drawing and even a model, is not a complete invention under the patent laws..." (section III). For example, in the applicants' disclosure, under section D of the Description of Invention, applicants rely upon a simple three-step block diagram showing the student running the training, student categorizing the training into four criteria and the student receiving just information that applies to their criteria. However, this block diagram is a mere vague idea of the invention and does not fully convey how the process shown in this block diagram can be implemented and how it meets the claims. The MPEP states that "...it was established that conception is more than a **mere vague idea** of how to solve a problem; the means themselves and their interaction must be comprehended also." (715.07, section III).

Furthermore, "the affidavit or declaration and exhibits must **clearly explain** which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. **Vague and general statements in broad terms** about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice 'amounts essentially to mere pleading, unsupported by proof or a showing of facts' and, thus, does not satisfy the requirements of 37 CFR 1.131 (b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974).

Art Unit: 2173

Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant..." (MPEP 715.07, section I). The applicants' declaration of prior invention is a general conclusory statement of what the exhibits describe and that the invention existed. However, adequate proof and showing of facts was not provided to show how the exhibits described in the declaration anticipate the limitations of the claims.

6. Due to the above reasons, the declaration of prior invention in the United States to overcome cited patent (37 C.F.R. 1.131), and the exhibits submitted therewith, fail to place the application in condition for allowance at the present time.



(KEVIN) NGUYEN  
PRIMARY EXAMINER